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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,488	06/09/2000	Dean F. Jerding	A-6600	2510

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SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
5030 SUGARLOAF PARKWAY
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EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

DATE MAILED: 06/07/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/590,488

Applicant(s)

JERDING ET AL.

Examiner

Scott Beliveau

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-65 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 38-65 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Miscellaneous

1. Pursuant to a further conversation with Sami O. Malas on 27 May 2004 regarding the Advisory Action, Paper No 17, the missing affidavit (Appendix A) referenced in Advisory Action was found having been mishandled by docketing. Accordingly, no further response is required by the applicant to the Advisory Action, Paper No. 17 and the examiner apologizes for any inconvenience. An action on the merits follows.

Response to Amendment

2. The affidavit under 37 CFR 1.132 filed 28 April 2004 is sufficient to overcome the rejection of claims 38-65 based upon the rejection under the Goel reference further shown in Exhibit A (Client User Interface Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal). In particular, both the reference and the instant application were not been invented by another as evidenced by the affidavit.

Response to Arguments

3. Applicant's arguments with respect to claims 38-65 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claims 38 and 56 are objected to because the phrase “the active VOD session” should be amended to recite “the active VOD session for a first VOD presentation” in order to provide proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 38-50 and 56-60 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “determining whether an active video-on-demand (VOD) session for a first VOD presentation exists”, does not reasonably provide enablement for “providing a list of selectable VOD titles responsive to determining that the active VOD session [for a first VOD presentation] does not exist”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. As illustrated in Figure 5, the embodiment determines if a current rental exists [193] (ex. Titanic) and if so provides the current rental screen [270]. If a current rental does not exist [193], then the embodiment provides the user with the list of titles for rental [195]. However, the particular determination associated with the determining that the active VOD session does not exist is not described as being a determination based on a particular “first VOD presentation” (ex. Titanic) not being active. Rather, the specification describes the process as merely being based on whether any active sessions exist (IA: Page 27, Lines 15-32) as opposed to being that for a particular

program (ex. Titanic). For example, the title catalog screen does not appear simply because a viewer does not have an active session for the first presentation (ex. Titanic).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 51, 53-55, 61, and 63-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Casement et al. (US Pat No. 5,969,748).

Claim 51 is rejected in light of the teachings of Casement et al. In particular, Casement et al. “provides a selectable option for renting a VOD presentation” in the form of an electronic program guide wherein the apparatus is operable to “receive a first user input configured to select the selectable option for renting the VOD presentation” thereby initiating the “rental” process (Col 6, Lines 13-29). As illustrated in conjunction with Figure 3, the apparatus “responsive to determining that the VOD presentation is block, prompts a user to provide a second user input identifying a first access code for unblocking the VOD presentation” [100], whereupon subsequent to “responsive to receiving the second user input identifying the first access code” [102], the user is “prompted . . . to provide a third user input identifying a second access code” [106]. Accordingly, presuming that both the “first” and

“second access codes” are correct, the apparatus “provides the user with the VOD presentation responsive to receiving the third user input” [110] (Col 6, Lines 30-47).

Claim 61 is rejected in view of Casement et al., which discloses a “digital home communication terminal (DHCT)” comprising “memory” [42] and “program code stored in said memory” (Col 3, Lines 8-32) associated with the electronic program guide functionality. As illustrated in Figure 3, Casement et al. discloses “prompting a user to provide a first user input identifying a first access code” [100/102], “prompting the user to provide a second user input identifying a second access code” [106/108], and “providing the user with the VOD presentation responsive to the DHCT receiving the first and second user inputs” [110] (Col 4, Lines 30-47).

Claims 53 and 63 are rejected wherein the “first and second access codes each includes a plurality of characters” (Col 7, Lines 38-40).

Claims 54 and 64 are rejected wherein the “first user input enables the VOD presentation to be unblocked” (Figure 4; Col 6, Line 48 – Col 7, Line 20).

Claims 65 and 65 are rejected wherein the “second user input enables the VOD presentation enables the VOD presentation to be rented” (Figure 5; Col 7, Lines 21-31).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
11. Claims 52 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casement et al. (US Pat No. 5,969,748).

In consideration of claims 52 and 62, while Casement et al. discloses the particular usage of “key-strokes” in conjunction with the user input device (Col 3, Lines 51-65), the reference does not explicitly disclose that the entry of the “first and second user inputs” are provided via a plurality of key-strokes”. Rather, the reference simply discloses that the passwords are entered, but does not particularly disclose how they are entered. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the aforementioned user input device so as to enter the multi-character passwords using a “plurality of key-strokes” for the purpose of providing a means or technique by which to facilitate the entry of the “first and second user inputs”.

12. Claims 38-41, 56, and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Dunn et al. (US Pat No. 5,721,829), in view of White et al. (US Pat No. 6,628,302).

Claim 38 is rejected in view of Dunn et al. which illustrates a method for “determining whether an active video-on-demand (VOD) session for a first VOD presentation exists” [204]

thereby providing the user with the ability “view the first VOD presentation responsive to determining that the active VOD session exists” [238]. Alternatively, the user is “provided a list of selectable VOD titles responsive to determining that the active VOD session does not exist” (Figure 3; Col 7, Lines 20-42).

The reference, however, does not disclose nor explicitly teach away from a modification so as to “provide a selectable option” in conjunction with the viewing the first VOD presentation. The commonly assigned White et al. reference discloses a scenario for “providing a selectable option to view the first VOD presentation” (Figure 5). This option is provided if playback of the presentation is paused/stopped by the user, but is not displayed if user the changes channels during the playback (Col 5, Lines 15-58). If the user stops playback of the presentation and changes channels, then upon returning to the video channel the “selectable option” would continue to be displayed, since the channel change occurred during the playback of the on-demand video as opposed to presentation being paused/stopped. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a “selectable option to view the first VOD presentation” [74] as taught by White et al. in response to determining that the active VOD session exists for the purpose of providing the user with a flexible and predictable means to control the playback of active video-on-demand presentations.

For example, it would be advantageous to “provide a selectable option to view the first VOD presentation” assuming that it is “active” if the user actively selected the option to stop the presentation as opposed to merely changing the channel. Alternatively, such a modification would be particularly useful to a user planning on repeatedly channel surfing

across the VOD channel given that the presentation would be repeatedly rewound and paused each time the user flipped by the channel if not actively paused during the initial playback.

Claim 56 is rejected in view of claim 38 wherein the aforementioned method is implemented via a “digital home communication terminal” [60] comprises “memory” [66] and “program code stored in said memory” so as to implement the method (Dunn et al.: Col 4, Line 47 – Col 5, Line 7).

Claims 39 and 57 are rejected wherein “responsive to receiving the user input”, “configured to select the selectable option to view the first VOD presentation”, the apparatus “provides the first VOD presentation to a user” (White et al.: Col 4, Lines 50-64).

Claims 40 and 41 are rejected wherein the apparatus is operable to “receive a first user input configured to select a VOD title form the list of selectable VOD titles” [92], “provide a selectable option for renting a second VOD presentation corresponding to the VOD title selected from the list of selectable titles” [86], and “receive a second user input configured to select the selectable option for renting the second VOD presentation” (Dunn et al.: Col 5, Lines 16-55).

13. Claims 42-50 and 58-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Dunn et al. (US Pat No. 5,721,829), in view of White et al. (US Pat No. 6,628,302), and in further view of Casement et al. (US Pat No. 5,969,748).

In consideration of claim 42-46, the combined teachings do not particularly disclose nor preclude the usage of determining whether or not selected presentations are blocked via both parental control and purchase access codes. The Casement et al. provides a method for renting a VOD presentation wherein “responsive to receiving the second user input,

determining whether the second VOD presentation is blocked”, the apparatus “prompts a user to provide a third user input identifying a first access code for unblocking the presentation”, and “receives the third user input identifying the first access code” [100/102]. Subsequently to “responsive to receiving the third user input identifying the first access code” [102], the user is “prompted . . . to provide a fourth user input identifying a second access code” [106]. Accordingly, presuming that both the “first” and “second access codes” are correct, the apparatus “provides the user with the VOD presentation responsive to receiving the third user input” [110] (Casement et al.: Figure 3; Col 6, Lines 30-47). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined teachings with that taught by Casement et al. for the purpose of advantageously providing a means to control access to television programs associated with both regular and on-demand programming (Casement et al.: Col 1, Lines 5-8, 26-63).

In consideration of claim 47, while Casement et al. discloses the particular usage of “key-strokes” in conjunction with the user input device (Col 3, Lines 51-65), the reference does not explicitly disclose that the entry of the “first and second user inputs” are provided via a plurality of key-strokes”. Rather, the reference simply discloses that the passwords are entered, but does not particularly disclose how they are entered. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the aforementioned user input device so as to enter the multi-character passwords using a “plurality of key-strokes” for the purpose of providing a means or technique by which to facilitate the entry of the “first and second user inputs”.

Claim 48 is rejected wherein the “first and second access codes each includes a plurality of characters” (Casement et al.: Col 7, Lines 38-40).

Claim 49 is rejected wherein the “first user input enables the VOD presentation to be unblocked” (Casement et al.: Figure 4; Col 6, Line 48 – Col 7, Line 20).

Claim 50 is rejected wherein the “second user input enables the VOD presentation enables the VOD presentation to be rented” (Casement et al.: Figure 5; Col 7, Lines 21-31).

Claim 58 is rejected wherein the “program code is further configured to provide a second VOD presentation identified in the list of selectable VOD titles responsive to receiving a first user input selecting the second VOD presentation” (Dunn et al.: Col 5, Lines 16-55), a “second user input identifying a first access code, and a third user input identifying a second access code” (Casement et al.: Figure 3; Col 6, Lines 30-47).

Claim 59 is rejected wherein the “first user input enables the VOD presentation to be unblocked” (Casement et al.: Figure 4; Col 6, Line 48 – Col 7, Line 20).

Claim 60 is rejected wherein the “second user input enables the VOD presentation enables the VOD presentation to be rented” (Casement et al.: Figure 5; Col 7, Lines 21-31).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

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- The Hancock et al. (US Pat No. 6,701,523) reference discloses a system for restricting access to television programs comprising an input for accepting cursor movement and selection commands.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

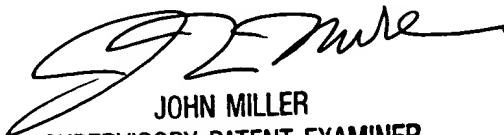
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

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SEB

May 31, 2004



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